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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,181	09/23/2003	Peter T. Aylward	86623LMB	4086

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EXAMINER

THOMPSON, CAMIE S

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*Mc*

**Office Action Summary**

**Application No.**

10/669,181

*FP*  
**Applicant(s)**

AYLWARD ET AL.

**Examiner**

Camie S. Thompson

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/23/05, 9/23/03.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 30-33 recites the limitation "said imaging layer" in line 2. There is insufficient antecedent basis for this limitation in the claim.

3. Claims 30-33 recites the limitation "said support" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Katashima et al., U.S. Patent Number 5,968,871.

Katashima disclose an article that has a base body that has at least one antistatic coat/layer on the surface of the base body (see column 2, lines 65-column 3, line 5). Additionally, the reference discloses that the antistatic layer has a conductive material (see column 4, lines 35-50). The reference also discloses that the antistatic layer has a patterned shape (see Figure 5 and column 4, lines 57-59). Katashima discloses a thermal transfer sheet that has excellent antistatic properties and that the antistatic coat that is present on the surface of a base body is used in the manufacture of a thermal transfer sheet.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2-4 and 15-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Majumdar et al., U.S. Patent Number 6,566,033 in view of Katashima et al., U.S. Patent Number 5,968,871.

Majumdar teaches an imaging support (see column 5, lines 45-46). Majumdar also teaches that the imaging member has a substrate that comprises a polymer foam core that has adhered to an upper and a lower flange sheet as per instant claims 19-20 (see column 5, lines 63-65).

Majumdar also teaches that the flange sheets comprise paper. The Majumdar reference also discloses an antistatic layer that has conductive material wherein the antistatic layer can be formed by thermal process such as extrusion, co-extrusion, with or without orientation, injection molding, blow molding and lamination (see column 14, lines 32-40). Also, Majumdar teaches that polyether-block polyamides are used in the antistatic layer as per instant 2-3 (see column 14, lines 40-51). Majumdar reference claim 6 teaches that the foam core sheet comprises polyolefin. Also, reference claims 10-11 of Majumdar teaches that the imaging layer comprises at least one layer comprising photosensitive silver halide, an ink jet receiving layer and a thermal dye-receiving layer or an electrophotographic layer. Column 17, lines 62-68 of the Majumdar reference discloses that support material (substrate) can be opaque or transparent and that the layers may be applied by blade coating, wound wire coating, slot coating, hopper coating, slide

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hopper coating, gravure coating or curtain coating as per instant claims 15, 18 and 26-28.

Column 8, line 67-column 9, line 4 of the reference discloses that the imaging element has three layers of a foam core and flange layer on each side and that additional layers can be used to change the properties of the element. Column 13-column 14 of the Mujumdar reference discloses that the antistatic layer can be placed on any side of the imaging element and that the antistatic layer can also comprise a polymer such as polyesters as per instant claims 34-36). The Mujumdar reference discloses that the antistatic layer needs to have a surface electrical resistivity of less than  $13 \log \text{ ohm/sq}$  as per instant claims 24-25 (see column 15, lines 19-24). The Mujumdar reference does not disclose a patterned image on the antistatic layer. Katashima disclose an article that has a base body that has at least one antistatic coat/layer on the surface of the base body (see column 2, lines 65-column 3, line 5). Additionally, the reference discloses that the antistatic layer has a conductive material (see column 4, lines 35-50). The reference also discloses that the antistatic layer has a patterned shape (see Figure 5 and column 4, lines 57-59). Katashima discloses a thermal transfer sheet that has excellent antistatic properties and that the antistatic coat that is present on the surface of a base body is used in the manufacture of a thermal transfer sheet. A detecting mark is provided to identify the positions and kinds of coloring material. Therefore, it would have been obvious to one of ordinary skill in the art to have a patterned image in the Mujumdar reference in order to effectively prevent the detection mark from being hidden by the antistatic coat/layer.

***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of copending Application No. 10/668,386. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications recite an article comprising a substrate/support having thereon at least one antistatic layer, wherein the antistatic layer comprises at least one conductive material and the antistatic layer comprises areas of patterned coverage. The co-pending application does not specifically recite that the patterned coverage is a


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graphic design. However, the co-pending application does recite that the areas of patterned coverage can be a shape, grid, or dot. A shape, grid or dot is specific to a generic graphic design. Therefore, it would have been obvious to one of ordinary skill in the art to have a patterned coverage that is a graphic design since a shape, grid or dot encompasses a graphic design.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (571) 272-1530. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L Dye, can be reached at (571) 272-3186. The fax phone number for the Group is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
RENA DYE  
SUPERVISORY PATENT EXAMINER  
A.U. 1774 9/2/05